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Paper No. 12

In re Application of :
Stephen R. Welch : DECISION ON REQUEST
Application No. 09/852,996 : FOR RECONSIDERATION
Filed: May 10, 2001 :
Attorney Docket No. 40040022.0026 :

This is a decision on the request for reconsideration filed on August 1, 2003 by which petitioner requests grant of the petition originally filed on June 25, 2003 so that the examiner's holding of abandonment would be withdrawn. No fee is required for the request for reconsideration.

The request for reconsideration is granted to the extent that the original Decision on Petition ("Decision") dated July 23, 2003 has been reconsidered in light of the record and the request for reconsideration, but, for the reasons that follow, is denied with respect to making any change in the holding of the original Decision.

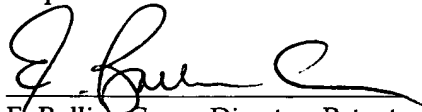
In the request for reconsideration, petitioner again argues that the examiner's outstanding Office Action (paper No. 4) was erroneous as having included a rejection that was based upon a document not qualifying as prior art. Petitioner also argues that there was an oral agreement to that the document was not prior art about which there was no "disagreement or doubt". (Emphasis is petitioner's).

As noted in the original Decision, the record shows no evidence of any agreement upon the part of the examiner to do anything with this application. Specifically, the examiner does not recall advising petitioner to fail to reply to the outstanding Office action. Petitioner has provided no evidence to the contrary.

As also noted in the original Decision, the examiner was without authority to waive the provisions of 35 USC § 133 or 37 CFR 1.135(a), or, for that matter, of 37 CFR 1.2. Petitioner may not have doubted that a particular document did not qualify as prior art, or what petitioner wanted to have the examiner do, but that simply does not excuse petitioner from complying with 35 USC § 133 and regulations that implement the statute and that required the filing a proper and timely reply to paper No. 4.

There is no basis provided by the record or in the petitions for withdrawing the holding of abandonment under 37 CFR 1.181. Mistaken positions are frequently taken during prosecution of patent applications, sometimes by the examiner and sometimes by counsel. There is no question of "embarrassment" attaching to correction of such errors during the prosecution of the application. Failing to reply to an outstanding Office action to spare the examiner "embarrassment" is simply not a course of action that is permitted by the statute or by the regulations. It appears that petitioner's remedy in this matter is to file a petition to revive pursuant to 37 CFR 1.137, which petition must include a complete reply to paper No. 4.

Request for reconsideration DENIED.


E. Rollins Cross, Director, Patent
Examining Groups 3710 and 3720

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